§101 Panel Checklist and Recommendations

Panel Members Present:

☐ Josie Ballato; SPRE ☐ Tom Black; SPE ☑ Wil Grant; QAS ☑ Pat Salce; QAS

☐ Tariq Hafiz; SPE ☐ Jack Harvey; QAS ☐ Gail Hayes; SPE ☑ Paul Sewell; QAS

☐ Eric Stamber; SPE ☑ Tod Swann; QAS ☐ Bob Weinhardt; BPSP

Annotation on the file wrapper (Example)

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	Date	Exmr.
§101 Panel Consulted: Harvey, Weinhardt, Swann	*07/13/02*	*wag*

Application Number: _____

Date of Panel: _____

Transitional Paragraph:

If you are also including a 35 U.S.C. §102, 103 or 112 rejection on any claims deemed non-statutory, it is recommended that a paragraph appear before that rejection with qualifying language similar to the following: To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Recommendations:

_____

_____

_____

Findings:

Basis	CLAIMS
☐ Functional Descriptive Material[1]	
☐ Data structure (non-interactive) (Descriptive material per se)	
☐ Computer Program (computer listing per se)	
☐ Nonfunctional Descriptive Material[2] (music, literature, art, photographs and mere arrangements or compilations of facts or data are merely stored)	
☐ Natural Phenomenon or Law of Nature[3]	
☐ Non - Statutory Process[4] (consist solely of mathematical operations without practical application in the technological arts or simply manipulates abstract ideas without practical application in the technological arts)	
☐ Claim Language Related to Mathematical Operation Steps of a Process[5]	
☐ Intended Use or Field of Use Statements	
☐ Necessary Antecedent Step to Performance of a Mathematical Operation or Independent Limitation on a Claimed Process	
☐ Post-Mathematical Operation Step Using Solution or Merely Conveying Result of Operation	

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[1] Examination Guidelines for Computer related inventions section IV. B1 (a); also see MPEP 2106
[2] IV. B1 (b)
[3] IV. B1 (c)
[4] IV. B2 (c)
[5] IV. B2 (d)

Computer-Related Inventions

II. Determine What Applicant Has Invented and Is Seeking to Patent

A. Identify and Understand Any Practical Application Asserted
for the Invention

B. Review the Detailed Disclosure and Specific Embodiments
of the Invention to Determine What the Applicant Has Invented

C. Review the Claims

III. Conduct a Thorough Search of the Prior Art

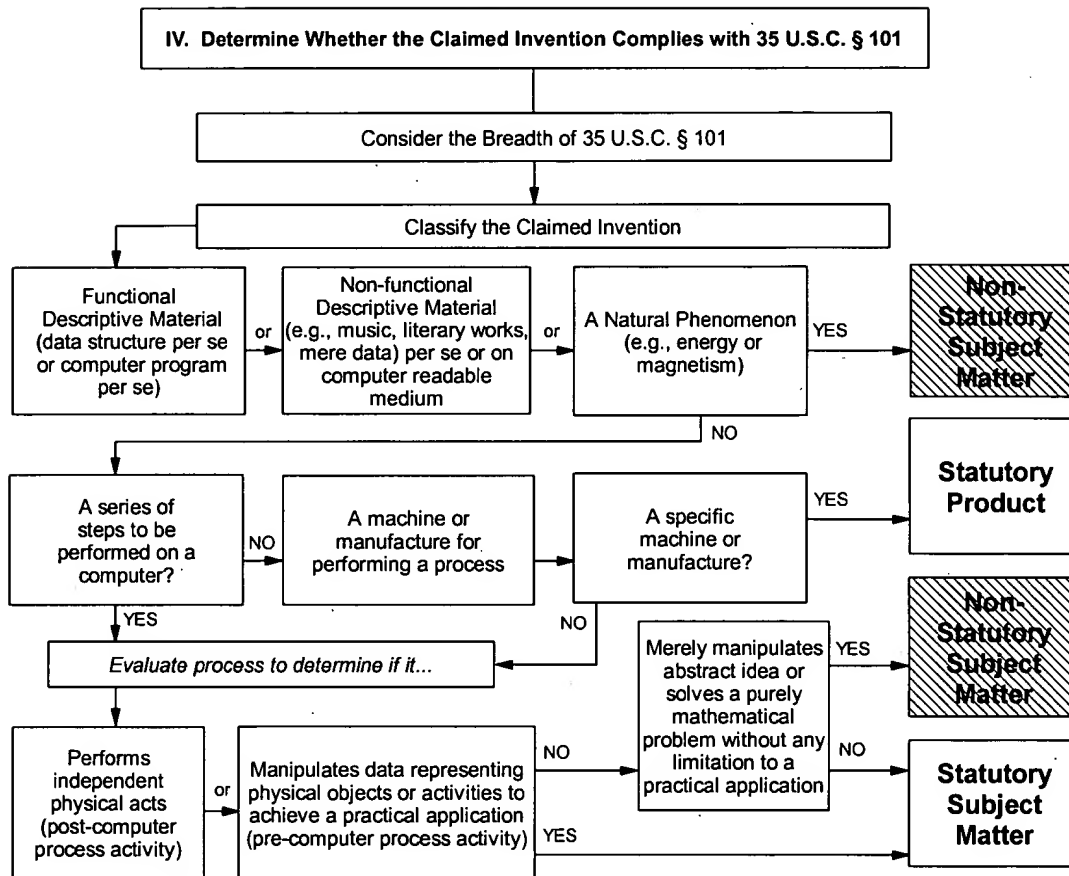**IV. Determine Whether the Claimed Invention Complies with 35 U.S.C. § 101**

◄——— **Insert Transitional Paragraph**

V. Evaluate Application for Compliance with 35 U.S.C. § 112

A. Determine Whether the Claimed Invention Complies with
35 U.S.C. § 112, Second Paragraph

1. Claims Setting Forth the Subject Matter Applicant
Regards as Invention

2. Claims Particularly Pointing Out and Distinctly
Claiming the Invention

B. Determine Whether the Claimed Invention Complies with
35 U.S.C. § 112, First Paragraph

1. Adequate Written Description

2. Enabling Disclosure

VI. Determine Whether the Claimed Invention Complies with 35 U.S.C. § § 102 and 103

VII. Clearly Communicate Findings, Conclusions and Their Bases

IV. Determine Whether the Claimed Invention Complies with 35 U.S.C. § 101

Consider the Breadth of 35 U.S.C. § 101

Classify the Claimed Invention

| Functional Descriptive Material (data structure per se or computer program per se) | or | Non-functional Descriptive Material (e.g., music, literary works, mere data) per se or on computer readable medium | or | A Natural Phenomenon (e.g., energy or magnetism) | YES | Non-Statutory Subject Matter |

NO

| A series of steps to be performed on a computer? | NO | A machine or manufacture for performing a process | | A specific machine or manufacture? | YES | Statutory Product |

YES

NO

Evaluate process to determine if it...

| | | Merely manipulates abstract idea or solves a purely mathematical problem without any limitation to a practical application | YES | Non-Statutory Subject Matter |

| Performs independent physical acts (post-computer process activity) | or | Manipulates data representing physical objects or activities to achieve a practical application (pre-computer process activity) | NO | | NO | Statutory Subject Matter |

YES

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

claims 8 , 35, 40, 46, 53

Statutory 5, 52, 56

Claim 56   Non - Descriptive /None functional
functional Relationship between the element
Just data

process applies the Boolean principle to produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle." *AT &T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999);

- "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a useful, concrete and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601; and

- Claims drawn to a rasterizer for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means were held to be directed to patentable subject matter since the claims defined "a specific machine to produce a useful, concrete, and tangible result." *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994).

A process that consists solely of the manipulation of an abstract idea is <u>not</u> concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The applicant is in the best position to explain why an invention is believed useful. Office personnel should therefore focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement. Office personnel should review the entire disclosure to determine the features necessary to accomplish at least one asserted practical application.

B. Review the Detailed Disclosure and Specific Embodiments of the Invention To Determine What the Applicant Has Invented

The written description will provide the clearest explanation of the applicant's invention, by exemplifying the invention, explaining how it relates to the prior art and explaining the relative significance of various features of the invention. Accordingly, Office personnel should begin their evaluation of a computer-related invention as follows:

— determine what the programmed computer does when it performs the processes dictated by the software (i.e., the functionality of the programmed computer) (*Arrhythmia*, 958 F.2d at 1057, 22 USPQ at 1036, "It is of course true that a modern digital computer manipulates data, usually in binary form, by performing mathematical operations, such as addition, subtraction, multiplication, division, or bit shifting, on the data. But this is only how the computer does what it does. Of importance is the significance of the data and their manipulation in the real world, i.e., what the computer is doing.");

— determine how the computer is to be configured to provide that <u>functionality</u> (i.e., what elements constitute the programmed computer and how those elements are